

Application No. 09/875,323
Response dated June 8, 2005
Reply to Office Action dated March 15, 2005
Attorney Docket No. 3833-010852

REMARKS

The issuance of the Advisory Action dated May 26, 2005 in response to Applicant's previous communication is appreciated. Applicant submits the present amendment with supporting remarks in a sincere effort to advance prosecution without the need for appeal or continuation.

The application is amended to place it in condition for allowance. In particular, claim 1 is amended as suggested by the Examiner in the Advisory Action, to define the phosphor material as being pre-reacted with the epoxy composition to suspend the phosphor within the epoxy followed by partially curing, or B-staging, the composition. Claim 12 is likewise amended to include similar language, by incorporating the language of original claim 14 therein, and canceling claim 14 accordingly.

The Advisory Action indicates that such language would be entertained. Applicant submits that the suggested language is not a new issue for consideration, and therefore requests that the claim language be considered in the present application without the need for a continuation application. First, it is noted that pending original claim 14 defines a molding compound prepared by B-staging, or partially curing, a partially cured mixture of an epoxy composition having a phosphor material substantially uniformly distributed therethrough, which mixture has been previously subjected to partial curing. The amended language of claim 1 parallels the language of original claim 14 in so far as it describes partial curing or B-staging a material which has already been partially cured. Therefore, the subject matter of amended claim 1 (as well as amended claim 12) has already been considered with respect to pending claim 14, and does not present a new issue. Further, the present amendment is based on language suggested by the Examiner in the Advisory Action. The Examiner's consideration of this issue is appreciated, and Applicant has amended the claims in accordance with the Examiner's suggestion and has pointed out how the original claims have already presented this issue for consideration. Accordingly, it is submitted that the amended claim language

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does not present a new issue, and therefore should be considered in the present case without the requirement of a continuation application.

Moreover, the Advisory Action sets forth that two of the previously cited references, namely Shaddock and Shimada, are no longer relied upon in the rejection of the claims, and has revised the claim rejection under 35 U.S.C. §103(a) as based on Japanese Patent No. 52-15539 (hereinafter "JP-539") as the primary reference. This rejection is respectfully traversed. In particular, only an English language translation of the abstract of JP-539 has been provided, and the abstract fails to teach, disclose, or even remotely suggest the claimed composition involving a partially cured or B-staged composition including a phosphor material substantially uniformly distributed therethrough, which has been subjected to a previous partial curing reaction to suspend the phosphor within the epoxy. It is well settled principle that the Examiner has the burden of establishing a prima facie case of obviousness when making a rejection under 35 U.S.C. § 103. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The Action, however, fails to set forth any basis as to how JP-539 teaches, discloses, or suggests the claimed composition involving such a partially cured or B-staged composition formed from an intermediate which has previously been partially cured. The abstract of JP-539 alone clearly does not support a prima facie case of obviousness. The Advisory Action further notes that a full English language translation of this Japanese reference has recently been ordered for further consideration. Applicant respectfully asserts that the prima facie case of obviousness is not properly supported, as indicated by the need to order the full translation for further consideration.

Moreover, the Advisory Action identifies an entirely new reference as being particularly relevant to the claims, namely Japanese Patent No. 63-100391 (hereinafter "JP-391"), which is admitted in the Action as being previously unconsidered. Since a new primary reference has been cited, Applicant respectfully requests that the finality of the rejection be withdrawn so that Applicant has an opportunity to address the issues raised relating to this newly cited reference. If this reference is to be maintained in a

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rejection, it is noted that the abstract of JP-391 clearly discusses a molding body obtained by dispersing a powdery phosphor material in a liquid epoxy composition, and then settling the powdery phosphor material prior to setting the epoxy liquid to form the molding body. Settling the phosphor material and then setting the epoxy composition does not suspend the phosphor material within the epoxy, and further partial curing or B-staging therefore would not produce a molding body which includes the phosphor material uniformly distributed throughout the molding composition. Even if the molding body were to be prepared only with the settled portion of the epoxy material which includes the settled phosphor particles, the phosphor material would not be suspended within the epoxy as required by the present claims, and there is nothing to ensure that such phosphor material is uniformly distributed throughout the molding compound, as required by the present claims. In fact, the teachings as set forth in this abstract of JP-391 clearly teaches away from the present invention by settling the phosphor material prior to partial curing, as opposed to suspending the phosphor material during partial curing followed by further partial curing or B-staging. Thus, even if applied to the claims, JP-391 fails to disclose, teach or suggest the claimed invention, and in fact teaches away from the claimed invention.

The Advisory Action further notes that in a continuing application, the full scope of the teachings of both of the Japanese references, namely JP-539 and JP-391, could be determined based on their English language translations, which apparently have been ordered. However, any further review of the English language translations of the references should occur in the present application. Applicant should be given the opportunity to respond to any reject based on the full translations in the present case without the burden of filing a continuation application, since the abstracts have already been considered and do not provide a basis for maintaining a rejection in and of themselves.

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In summary:

- 1) The present amendment to the claims does not introduce a new issue, in that the original claims included the subject matter of the present claim amendments as noted above, and in fact has been explicitly suggested for inclusion by way of the Advisory Action. As such, it cannot be said that such language raises a new issue, and full consideration should be given to such language at the present stage of prosecution.
- 2) The current claim rejection based on JP-539 fails to present a prima facie case of obviousness, in that the rejection fails to demonstrate how the reference teaches, discloses or suggests a pre-reaction to suspend the phosphor in the epoxy followed by partial curing or B-staging to form a composition. Accordingly, any further consideration of the full translation of this reference or any other reference should be made in the present application without need for a continuation case at Applicant's expense, with the Applicant having an appropriate opportunity to respond to any further rejections in the present case based on the full translations of the documents.

Applicant has properly addressed each and every rejection to date, and is therefore respectfully requesting an opportunity to respond to any further issues in the present application, without the additional time and expense required of a continuation application. To require the filing of a continuation application would place an undue burden on the Applicant, particularly in a case where the primary reference has been removed, and the claims have been amended in accordance with the Examiner's suggestion to overcome the remaining references based on subject matter present in the original claims.

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In view of the above amendments and remarks, Applicant submits that the continued rejection of the claims is improper. Accordingly, entry of the amendment, withdrawal of the rejection, and allowance of the claims are respectfully requested. In the alternative, Applicant respectfully requests removal of the finality of the rejection and reconsideration of the application based on the Examiner's further review of the English language translations of the Japanese references, since it has been established that the cited abstracts alone fail to provide a basis for a prima facie case of obviousness.

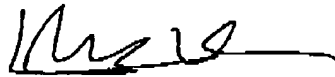
Any questions regarding this communication may be directed to Applicant's undersigned attorney, who can be reached by telephone at 412-471-8815.

Respectfully submitted,

THE WEBB LAW FIRM

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By



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